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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,949	03/07/2002	Rainer Tilse	4597-039	2820

7590

11/19/2003

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EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/069,949

Applicant(s)

TILSE, RAINER

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure, as filed, fails to enable one of ordinary skill in the art to make a sound vibrating spray gun, see claim 10. There is no teaching as to how to make or use such a device. The disclosure, as filed, fails to enable one of ordinary skill in the art to make a sound vibrating dental handpiece, see claim 11. There is no teaching as to how to make or use such a device.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language "especially ultra sound" throughout the claims is indefinite as to whether or not the limitation is being claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 4, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirdes (4768955). Hirdes shows a supply container 5, nozzle 10, 11, means for conveying 3, handle 2 and ultra sound generator 50, column 4, lines 60-67. All of the claimed structure being shown, the intended use with a resin based filling compound is given no patentable weight. As to claims 9 and 12, see actuating button 6. As to claim 11, Hirdes inherently shows a dental handpiece because it is a dental instrument to be hand held. It is noted that the present disclosure is silent on the definition of the term "handpiece".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takatsu (4850875) in view of Smith (3792530). Takatsu teaches a filling method for resin using filling and forming instruments that produce ultra sonic vibrations to

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condition the filling material, column 2, lines 49-53, and gives an example of known filling instruments, column 1, lines 25-35. Takatsu does not state vibrating the filling instrument while filling a cavity. Smith teaches using a filling instrument that applies vibration to condition a filling material while the material is being dispensed, column 6, lines 30-44. It would be obvious to one of ordinary skill in the art to modify Takatsu to include the use of an instrument that applies vibrations while the cavity is being filled as shown by Smith in order to better condition the filling material.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirdes (4768955) in view of Nielsen (3890713). Hirdes shows the structure as described above, however, does not show an exchangeable supply container. Nielsen shows an exchangeable supply container and nozzle, see Figs. 7-9. It would be obvious to one of ordinary skill in the art to modify Hirdes to include an exchangeable container as shown by Nielsen in order to more conveniently refill the handpiece. As to claim 8, Hirdes does not show the use of a pneumatically excited oscillator. Nielsen shows creating vibrations with a pneumatic oscillator, column 2, lines 62-64. It would be obvious to one of ordinary skill in the art to modify Hirdes to include the use of a pneumatic oscillator as shown by Nielsen in order to make use of art known equivalent ways of producing vibrations. It is also noted that there is no disclosed criticality to the type of oscillator used.

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Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirdes (4768955) in view of Werly (5007837). Hirdes shows the structure as described above, however, does not show the use of a piezoelectric oscillator. Werly shows creating vibrations with a piezoelectric oscillator 41. It would be obvious to one of ordinary skill in the art to modify Hirdes to include the use of a piezoelectric oscillator as shown by Werly in order to make use of art known equivalent ways of producing vibrations. It is also noted that there is no disclosed criticality to the type of oscillator used.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirdes (4768955) in view of Balamuth et al (3809977). Hirdes shows the structure as described above, however, does not show the use of a magetostriuctive oscillator. Balamuth shows creating vibrations with a magetostriuctive oscillator, column 7, lines 28-34. It would be obvious to one of ordinary skill in the art to modify Hirdes to include the use of a magetostriuctive oscillator as shown by Balamuth in order to make use of art known equivalent ways of producing vibrations. It is also noted that there is no disclosed criticality to the type of oscillator used.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirdes (4768955) in view of Fishburne, Jr. (5839895). Hirdes shows the structure as described above, however, does not show the use of a spray gun. Fishburne teaches that the structure produces a spray, column 5, lines 1-5. It would be obvious to one of ordinary skill in the art to modify Hirdes to include producing a spay as shown by Fishburne in

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order to make use of known properties of art known delivery devices. It is further noted that the present disclosure does not specify any specific type of spray gun, therefore, to call the above combination a spray gun is an obvious matter of choice to the skilled artisan.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide support for a spray gun and does not provide support for a dental handpiece with sound vibrating means.

The Abstract is missing.

Drawings

The drawings filed March 7, 2002 are objected to because of the use of poor quality hand drawn lines.

Claimed features must be shown in the drawing, therefore, a spray gun and dental handpiece must be shown. No new matter may be added.

Priority

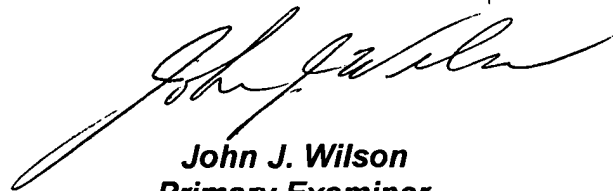
Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gayso (3898739) and Noll et al (3751807) shows vibrating devices. Soulie (FR 2190176) and Boehm (EP 0970717) were cited in a corresponding PCT application.

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.



**John J. Wilson
Primary Examiner
Art Unit 3732**

jjw

November 7, 2003

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Work Schedule: Monday through Friday, Flex Time